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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,877	12/12/2003	Jing Wu	2021.0066-02	8138
22852	7590	07/22/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			KIFLE, BRUCK	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,877

Applicant(s)

WU ET AL.

Examiner

Bruck Kifle, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91-118 is/are pending in the application.
- 4a) Of the above claim(s) 92-104 and 106-118 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 91 and 105 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restriction

Applicant's election of the compound disclosed on page 112, Table 6-1 and exemplified in Example 6-1 on page 284 in the reply filed on 07/11/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The rings embraced at W, together with $-C(H)_pC(=X)$ and at Q, are patentably distinct and are so diverse in scope that a serious burden exists to search the application as a whole. Therefore restriction to a specific core is required. Each ring supports a different patent. For example, considering a tiny subset of rings embraced by W, together with $-C(H)_pC(=X)$ and "Q" represents isoquinolinone is classified in 546/139; benzothiazines in 544/11; quinazolines in 544/283; pyridobenzothiazepinones in 540/488; 1,4-benzodiazepinones in 540/504; etc. These exemplary classifications indicate the serious burden placed on the office.

The search required is too burdensome for the office. The compounds of formula IA and IB embrace varying sizes of rings with multiple heteroatoms and further ring fusions that a reasonable search of the entire genus could not be conducted without undue burden.

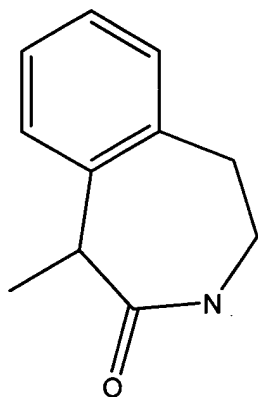
The compounds embraced by the instant claims are drawn to structurally dissimilar compounds. They are made and used independently. They are independent and patentably distinct.

If, say a naphthalene as the ring formed by W, together with $-C(H)_pC(=X)$ and Q, were anticipated, applicants would not acquiesce in the rejection of, say, a purine thereover or vice-versa. They are patentably distinct.

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The search required for any one of the rings formed by W, together with $-C(H)_pC(=X)$ and Q, is not required for another.

The elected species was not found and the search was expanded according to MPEP 803.02 to embrace compounds of formula IA wherein W, together with $-C(H)_pC(=X)$ forms



along with the full scope of the remaining variables.

Claims 92-104 and 106-118 along with subject matter not embraced by this ring system of the remaining claims are withdrawn from consideration as being drawn to non-elected subject matter.

Provisos

There are provisos in the claims that exclude compounds embraced by the claims. If these provisos are present to avoid prior art, applicants are urgently requested to point out these references to the examiner because of their importance in the examination of the claims.

Improper Markush Rejection

Claims 91 and 105 are rejected as being drawn to an improper Markush group, that is, the claims lack unity of invention. The variable W, together with $-C(H)_pC(=X)$ is defined in such a way that it keeps changing the core of the compound that determines the classification. By changing this value, several patentably distinct and independent compounds are claimed. In order

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to have unity of invention the compounds must have "a community of chemical or physical characteristics" which justify their inclusion in a common group, and that such inclusion is not repugnant to principles of scientific classification" In re JONES (CCPA) 74 USPQ 149 (see footnote 2). The structural formula IA does not have a significant structural feature that is shared by all of its alternatives which is inventive. Compounds embraced by formula IA are so diverse in nature that a prior art anticipating a claim with respect to one member under 35 USC 102 would not render obvious the same claim under 35 USC 103. This is evidentiary of patentably distinct and independent inventions.

Limiting the claims to the elected group would overcome this rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 571-272-0668. The examiner can normally be reached Tuesdays to Fridays between 8:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK
July 19, 2005